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PPW

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Phan, et al.)
Appl. No.: 10/086,941)
Filed: February 26, 2002)
For: METHODS FOR DNA)
CONJUGATION ONTO SOLID)
PHASE INCLUDING RELATED)
OPTICAL BIODISCS AND DISC)
DRIVE SYSTEMS)
Examiner: Frank W. Lu)
Group Art Unit: 1634)

PETITION UNDER 37 C.F.R. § 1.183 REQUESTING A WAIVER OF 37 C.F.R. § 1.67

Mail Stop Petition

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed March 25, 2005, Applicants hereby petition under the provisions of 37 C.F.R. § 1.183, that the Commissioner waive the requirements of 37 C.F.R. § 1.67 and accept for filing and examine the above-identified patent application despite the fact that the Oath/Declaration filed on July 5, 2002, includes a non-initialed, non-dated alteration of inventor KaYuen Yeung's address. Applicants have been unable to secure another oath/declaration from KaYuen Yeung despite diligent efforts. In support for this petition, Applicants provide the following:

09/01/2005 TBESHASH1 00000017 10086941

01 FC:1462

400.00 DP

Appl. No.: **10/086,941**
Filed: **February 26, 2002**

DECLARATION OF INVENTORSHIP

When the instant Application was filed on February 26, 2002, a Declaration of Inventorship was also filed that was executed by three of the four inventors, Brigitte Chau Phan, Jorma Ante Virtanen, and Amethyst Hoang Lam. On April 5, 2002, a Notice of Missing Parts was mailed indicating that a filing fee and Declaration needed to be filed in the above captioned Application. In response, another Declaration of Inventorship was submitted on July 5, 2002, which was executed by KaYuen Yeung (the inventor who had not signed the original Declaration submitted on February 26, 2002).

In an Office Action mailed on March 25, 2005, the Examiner noted that the July 5, 2002, Declaration of Inventorship was defective because the original typed address of inventor KaYuen Yeung had been lined-out and replaced with a handwritten address. This change had not been initialed or dated. As such, the Examiner requested that a new Declaration of Inventorship be provided.

Despite diligent efforts outlined in the attached Declaration of Jerry L. Hefner, Applicants have been unable to secure a replacement Declaration of Inventorship from KaYuen Yeung. Applicants therefore respectfully submit that the Declarations of Inventorship filed on February 26, 2002 and July 5, 2002, which include unaltered signatures of three of the four inventors, Brigitte Chau Phan, Jorma Ante Virtenen, and Amethyst Hoang Lam, and a handwritten replacement address for KaYuen Yeung satisfy the requirement of 37 C.F.R. §§ 1.63 and 1.67.

STATEMENTS OF FACTS

Applicant provides the following Declaration, attached herewith, in support of its conclusion that KaYuen Yeung refuses to sign and/or cannot be reached:

1. Declaration of Jerry L. Hefner in Support of Petition under 37 C.F.R. § 1.183 seeking a waiver of 37 C.F.R. § 1.67.

The Declaration shows the efforts of Applicants to contact KaYuen Yeung by certified U.S. Mail and Express Mail to obtain her cooperation. Despite these diligent efforts, Applicants have been unable to contact KaYuen Yeung or obtain an unaltered Declaration of Inventorship from her.

Appl. No.: **10/086,941**
Filed: **February 26, 2002**

LAST KNOWN ADDRESS OF THE NONSIGNING INVENTORS

The last known address for KaYuen Yeung is: 1326 Third Avenue, San Francisco, CA 94122. KaYuen Yeung is a United States citizen.

CONCLUSION

Based on the foregoing, it is submitted that diligent efforts has been made to obtain an unaltered Declaration of Inventorship from KaYuen Yeung. Despite these diligent efforts, Applicants have not been able to obtain another declaration from KaYuen Yeung. Applicants respectfully submit that the Declarations of Inventorship submitted on February 26, 2002 and July 5, 2002, satisfy the requirement that all available joint inventors (i) make oath or declaration on their own behalf as required by 37 C.F.R. § 1.63 and (ii) request waiver of 37 C.F.R. § 1.67 requiring that a Supplemental Declaration of Inventorship be provided.

Applicants respectfully request that this petition under 37 C.F.R. §1.183 be granted and that the Applicants be allowed to file and prosecute the above-identified patent application without an unaltered oath/declaration from KaYuen Yeung. If there are any obstacles to a prompt approval of this petition, the Patent and Trademark Office is invited to call the undersigned attorney.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 25, 2005

By: 
Jerry L. Hefner
Registration No. 53,009
Attorney of Record
Customer No. 20,995
(619) 235-8550

1863664
081105

Please Direct All Correspondence to Customer Number 20995



PETITION TRANSMITTAL

Applicant : Phan, et al.
 App. No : 10/086,941
 Filed : February 26, 2002
 For : METHODS FOR DNA CONJUGATION ONTO SOLID PHASE INCLUDING RELATED OPTICAL BIODISCS AND DISC DRIVE SYSTEMS
 Examiner : Frank W. M. Lu
 Art Unit : 1634

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

August 25, 2005

(Date)

Jerry L. Hefner, Reg. No. 53,009

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing in the above-identified application are the following enclosures:

- (X) Petition Under 37 C.F.R. § 1.183 Requesting A Waiver of 37 C.F.R. § 1.67
- (X) Declaration in Support of Petition Under 37 C.F.R. § 1.183 Requesting A Waiver of 37 C.F.R. § 1.67
- (X) A check in the amount of \$400 to cover the required fee under 37 C.F.R. § 1.17(f) is enclosed.
- (X) Return prepaid postcard.

The present application qualifies for Small Entity Status under 37 CFR 1.27.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Jerry L. Hefner
Registration No. 53,009
Attorney of Record
Customer No. 20,995
(619) 235-8550



DECLARATION IN SUPPORT OF PETITION UNDER 37 CFR 1.183

REQUESTING A WAIVER OF 37 C.F.R. § 1.167

I, Jerry L. Hefner, hereby declare that, to the best of my knowledge, information, and belief, the following is true, accurate, and correct:

- 1) I am an associate attorney at Knobbe, Martens, Olson & Bear, LLP ("KMOB") and help coordinate prosecution of patent matters assigned to our client, Nagaoka and Co., LTD ("Nagaoka").
- 2) On November 4, 2003, Burstein Technologies, Inc. ("BTI") sold an undivided partial ownership interest in all intellectual property matters to Nagaoka. Prior to November 4, 2003, BTI terminated all employees.
- 3) On February 26, 2002, a patent application was filed on behalf of BTI, entitled "Methods for DNA conjugation onto solid phase including related optical biodiscs and disc drive systems." This application claims priority to provisional applications and is subject to the November 4, 2003 assignment from BTI to Nagaoka. Accordingly, the listed inventors were previous employees of BTI.
- 4) This application was assigned Application Number 10/086,941 ("the '941' application") by the U.S. Patent and Trademark Office.
- 5) Filed concurrently with the patent application on February 26, 2002, was a Declaration of Inventorship executed by three of the four inventors, Brigitte Chau Phan, Jorma Antero Virtanen, and Amethyst Hoang Lam. The fourth inventor, KaYuen Yeung, did not sign the declaration.
- 6) The U.S. Patent and Trademark Office mailed a Notice To File Missing Parts Of Nonprovisional Application on April 5, 2002, indicating that the signature of the fourth inventor was missing from the declaration. The missing parts notice set a two month initial deadline for submitting the missing declaration. Thus, the initial deadline for filing these documents was June 05, 2002.
- 7) A Response to the Notice to File Missing Parts was filed on July 5, 2002, including a Declaration of Inventorship signed by the fourth inventor, KaYuen Yeung, and also the first inventor, Brigitte Chau Phan, who had also previously signed the February 26, 2002

**Diligent Efforts Attempting to Secure an Unaltered Declaration of Inventorship from
KaYuen Yeung**

Declaration of Inventorship. The residence address for Ms. Yeung that was provided on the original Declaration of Inventorship was lined-out and replaced with a hand written address. This change was not initialed or dated by Ms. Yeung.

- 8) An Office Action was mailed on March 25, 2005, wherein the Examiner informed Applicants that the Oath/Declaration filed on July 5, 2002, was defective because there was a non-initialed, non-dated alteration to the address of inventor KaYuen Yeung.
- 9) After receiving the March 25, 2005, Office Action, I attempted to contact KaYuen Yeung to secure an unaltered Declaration of Inventorship for the '941 application. As outlined below, however, despite diligent efforts I was unable to secure an unaltered, executed declaration from KaYuen Yeung.
- 10) On or about July 11, 2005, I prepared a letter addressed to KaYuen Yeung, which explained that the filing of US Patent Application No. 10/086,941 would be incomplete unless she signed and returned to us the Declaration of Inventorship that was enclosed with the letter. The letter stated that if Ms. Yeung did not return the Declaration of Inventorship by August 12, 2005 or at least attempt to contact me by phone, fax, email or mail, that the non-response would be treated as her refusal to cooperate in the Declaration of the patent application. The letter is attached as Exhibit A.
- 11) On July 11, 2005, the letter described in item 10, a Declaration of Inventorship and a complete copy of the patent application, which included the specification, claims and drawings, was sent together via U.S. Certified Mail to Ms. Yeung's address at 1326 Third Avenue, San Francisco, CA 94122 (Exhibit B). The U.S. Postal Service tracking results (attached hereto as Exhibit C), which were obtained on August 23, 2005, show that the delivery of this mailing was attempted but unsuccessful. These results also indicate that a notice regarding the attempted delivery was left at the residence. Currently, this mailing remains at the Post Office in San Francisco.
- 12) On or about July 11, 2005, a duplicate mailing containing the letter described in item 10, a Declaration of Inventorship and a complete copy of the patent application was sent by Federal Express to the above address (Exhibit D). The Federal Express tracking results (attached hereto as Exhibit E) show that the duplicate mailing was delivered on July 12, 2005.

**Diligent Efforts Attempting to Secure an Unaltered Declaration of Inventorship from
KaYuen Yeung**

- 13) Previous to the mailings described in items 10, 11 and 12, I made numerous attempts to contact KaYuen Yeung in order to request that she execute a Declaration of Inventorship in connection with another patent application (U.S. Patent Application No. 10/087,549) that had been filed on behalf of BTI and assigned to Nagaoka as stated in item 2. Because none of the above-mentioned attempts were successful, on October 27, 2004, I filed a petition under Rule 1.47(a) requesting a waiver of the requirement that Ms. Yeung execute a Declaration of Inventorship in connection with U.S. Patent Application No. 10/087,549. This petition was treated as a petition under 37 C.F.R. § 1.183 and granted (Exhibit F).
- 14) Although it has been more than 40 days since the mailings described in items 11 and 12, I have not received a response from Ms. Yeung.

Signature:



Jerry L. Hefner

Date:

August 25, 2005

1863548:081105

Knobbe Martens Olson & Bear LLP

Intellectual Property Law

550 West C Street
Suite 1200
San Diego CA 92101
Tel 619-235-8550
Fax 619-235-0176
www.kmob.com

Jerry L. Hefner, Ph.D.
jhefner@kmob.com

July 11, 2005

VIA FEDERAL EXPRESS AND CERTIFIED MAIL

KaYuen Yeung
1326 Third Ave.
San Francisco, CA 94122

Re: U.S. Patent Application

Title: METHODS FOR DNA CONJUGATION ONTO SOLID PHASE
INCLUDING RELATED OPTICAL BIODISCS AND DISC DRIVE SYSTEMS

Application No.: 10/086,941

Filed: February 26, 2002

Our Reference: NAGACO.021CP

Dear Ms. Yeung:

Our firm, Knobbe, Martens, Olson & Bear, LLP, is currently handling the prosecution of several U.S. Patent Applications for Nagaoka & Co. Ltd. You are listed as an inventor on an application entitled "METHODS FOR DNA CONJUGATION ONTO SOLID PHASE INCLUDING RELATED OPTICAL BIODISCS AND DISC DRIVE SYSTEMS" which was filed in the U.S. Patent Office on February 26, 2002. **Enclosed herewith is a copy of the application, including the specification, claims and drawings, for your review.**

The U.S. Patent and Trademark Office (USPTO) has notified us that the Supplemental Declaration of Inventorship that you signed on June 29, 2002 is not acceptable in view of the uninitialed, handwritten change of address that was made at the time of signing. Unfortunately, the USPTO is now requiring that we file a replacement Declaration of Inventorship containing an updated address. **As such, we ask that you please sign the copy of the replacement Declaration of Inventorship that we are enclosing herewith.**

In order to keep this patent application pending, it is critical that we meet certain deadlines for filing the replacement Declaration of Inventorship. Accordingly, we would greatly appreciate your prompt action in this matter. If the replacement Declaration is accurate, please sign and return the signed document to me via facsimile at 619-235-0176. If this document is in error, please contact me by E-mail (at the above-indicated address) or by telephone at 619-235-8550 prior to August 12, 2005, so that we may discuss the most expedient method for providing you with correct copies of these documents for your signature.

EXHIBIT A

Orange County
949-760-0404

San Francisco
415-954-4114

Los Angeles
310-551-3450

Riverside
951-781-9231

San Luis Obispo
805-547-5580

KaYuen Yeung
July 11, 2005
Page -2-

Given the urgency of this situation, IF YOU DO NOT RESPOND TO THIS LETTER BY AUGUST 12, 2005, YOUR NON-RESPONSE WILL INDICATE THAT YOU REFUSE TO SIGN THE DECLARATION OF INVENTORSHIP PROVIDED HEREWITH AND THAT YOU REFUSE TO COOPERATE IN THE PROSECUTION OF THIS PATENT APPLICATION.

We look forward to hearing back from you soon.

Sincerely,



Jerry L. Hefner

Enclosures

1807910
071105

CERTIFIED MAIL™



7004 0750 0002 8444 9697

From: Knobbe Martens Olson & Bear LLP
To: [REDACTED]

Intellectual Property Law

550 West C Street, Suite 1200, San Diego, CA 92101

Postmark
Here

Ka Yuen Yeung
1326 Third Avenue
San Francisco, CA 94122

NAGACO. 021CP

JTH

SENDER: COMPLETE THIS SECTION

- Complete Items 1, 2, and 3. Also complete Item 4 if Restricted Delivery is desired.
 - Print your name and address on the reverse so that we can return the card to you.
 - Attach this card to the back of the mailpiece, or on the front if space permits.
1. Article Addressed to:

Ka Yuen Yeung
1326 Third Ave.
San Francisco, CA 94122

COMPLETE THIS SECTION ON DELIVERY

- | | |
|-------------------------------|------------------------------------|
| A. Signature | <input type="checkbox"/> Agent |
| X | <input type="checkbox"/> Addressee |
| B. Received by (Printed Name) | C. Date of Delivery |
- D. Is delivery address different from item 1? Yes
If YES, enter delivery address below: No

3. Service Type
- Certified Mail Express Mail
 Registered Return Receipt for Merchandise
 Insured Mail C.O.D.
4. Restricted Delivery? (Extra Fee) Yes

PS Form 3800, June 2002
Transfer fil
2. Article Number
3. Domestic Return Receipt

PS Form 3811, February 2004
Domestic Return Receipt
102595-02-M-1540

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EXHIBIT B

**U.S. Postal Service™
CERTIFIED MAIL™ RECEIPT**
(Domestic Mail Only; No Insurance Coverage Provided)

For delivery information visit our website at www.usps.com

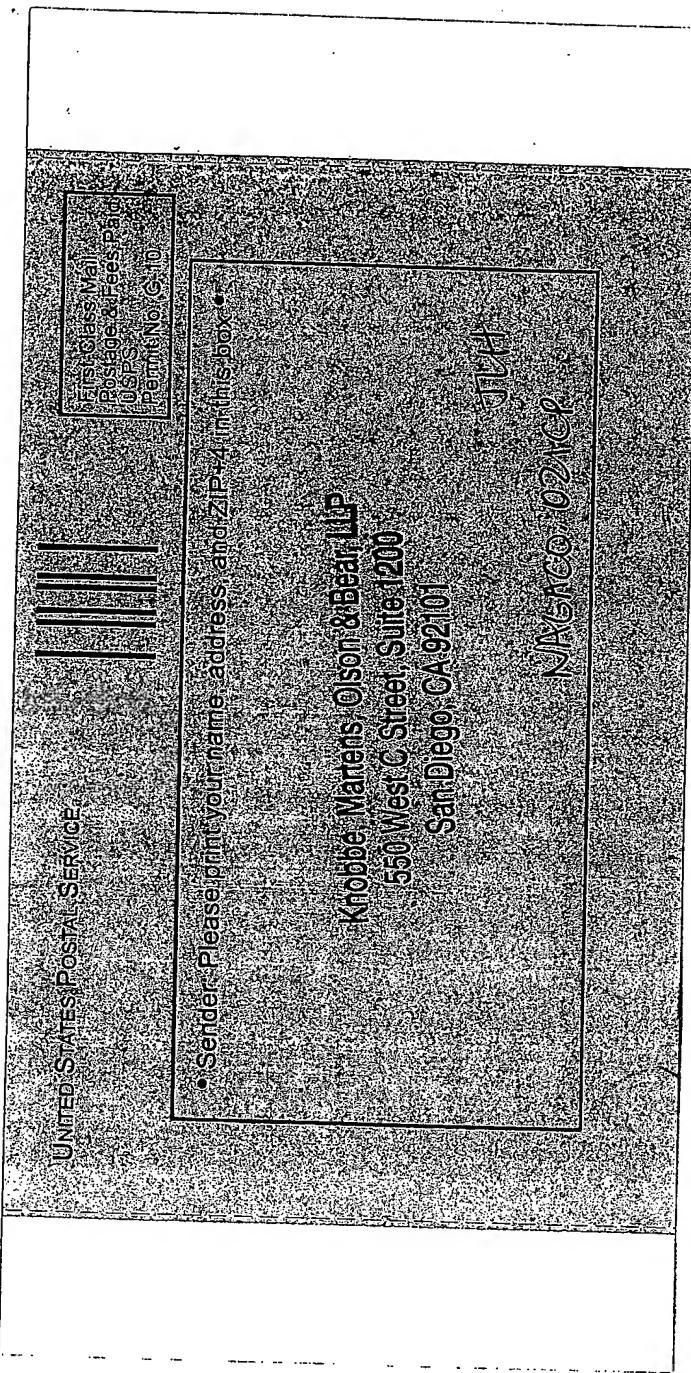
OFFICIAL USE

Postage	\$
Certified Fee	
Return Receipt Fee (Endorsement Required)	
Restricted Delivery Fee (Endorsement Required)	
Total Postage & Fees	\$

Sent To: Ka Yuen Yeung
Street, Apt. No.: 1326 Third Ave.
or PO Box No.:
City, State, ZIP+4: SAN FRANCISCO, CA 94122

PS Form 3800, June 2002

See Reverse for Instructions



BEST AVAILABLE COPY

SENDER: COMPLETE THIS SECTION

COMPLETE THIS SECTION ON DELIVERY

Signature _____
X

Family Name _____ Given Name _____
Print your name and address as desired
So we can find you if necessary
Address _____
On back of envelope or back of the mailing label

Telephone number _____

Agent _____
 Addressee _____

1324 MARKET
SAN FRANCISCO CA 94102

Same as above
 Mural Mail _____
 Express Mail _____
 Registered Mail _____
 Return Receipt for Merchandise _____
 Insured Mail _____
 C.O.D. _____
 Special Delivery (Extra Fee) _____
 Yes _____

7004 0750 0002 8444 9697

Postage _____
Date _____
Form 3811 January 2000
Post Office Department
Washington, D.C. 20585-0001

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Track & Confirm

Search Results

Label/Receipt Number: 7004 0750 0002 8444 9697

Status: Notice Left

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EXHIBIT C

FedEx
Tracking
Number

81 4 5079 4911

OM Please print and press hard.

To Sender's FedEx Account Number 1241-6073-1

Name Jerry Hefner Phone (619) 235-8550

Company KNOBBE MARTENS OLSON & BEAR

Address 550 W C ST STE 1200 Dept./Floor/Suite/Room

City SAN DIEGO State CA ZIP 92101

Our Internal Billing Reference (24 characters will appear on invoice.) OPTIONAL

Recipient's Name Ka Yuen Yeung Phone ()

Company

Address

HOLD at FedEx location, print FedEx address. We cannot deliver to P.O. boxes or P.O. ZIP codes.

Address 1326 Third Ave. Dept./Floor/Suite/Room

City San Francisco State CA ZIP 94122

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JULY 0210457560

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4a Express Package Service

 FedEx Priority Overnight Next business morning FedEx Standard Overnight Next business afternoonPackages up to 150 lbs.
Delivery commitment may be later in some areas. FedEx First Overnight Earliest next business morning delivery to select locations FedEx 2Day Second business day FedEx Express Saver Third business day
FedEx Envelope rate not available. Minimum charge: One-pound rate

4b Express Freight Service

 FedEx 1Day Freight* Next business day FedEx 2Day Freight Second business dayPackages over 150 lbs.
Delivery commitment may be later in some areas. FedEx 3Day Freight Third business day

*Call for Confirmation:

5 Packaging

 FedEx Envelope* FedEx Pak*
Includes FedEx Small Pak, FedEx Large Pak, and FedEx Sturdy Pak

Declared value limit \$500

 Other

6 Special Handling

 SATURDAY Delivery HOLD Weekly HOLD Saturday Available ONLY for FedEx Priority Overnight and FedEx 2Day to select ZIP codesat FedEx Location
NOT Available for
FedEx First Overnightat FedEx Location
Available ONLY for
FedEx Priority Overnight and
FedEx 2Day to select locations

Does this shipment contain dangerous goods?

One box must be checked.

 No Yes As per attached
Shipper's Declaration
Shipper's Declaration
not required Dry Ice
Dry Ics, 9, UN 1845 _____ kg
 Cargo Aircraft Only

7 Payment Bill to:

 Sender Enter FedEx Acct. No. or Credit Card No. below.
Acct. No. in Section 1 will be billed. Recipient Third Party Credit Card Cash/Check

FedEx Acct. No.

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Date

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†Our liability is limited to \$100 unless you declare a higher value. See back for details.

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8 Release Signature

Sign to authorize delivery without obtaining signature.

By signing you authorize us to deliver this shipment without obtaining a signature
and agree to indemnify and hold us harmless from any resulting claims.

447

SF# Rev. Date 10/01 • Part #1576103 • ©1994-2001 FedEx PRINTED IN U.S.A.

EXHIBIT D


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Tracking number 832450794911 **Signed for by** Signature release on file
Ship date Jul 11, 2005 **Service type** Priority Envelope
Delivery date Jul 12, 2005 9:15 AM
Status Delivered

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	8:06 AM	At local FedEx facility	SOUTH SAN FRANCISCO, CA	
	6:37 AM	Departed FedEx location	OAKLAND, CA	
Jul 11, 2005	7:21 PM	Left origin	SAN DIEGO, CA	
	5:13 PM	Picked up	SAN DIEGO, CA	

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Delivery updates

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<input type="text"/>	English <input checked="" type="checkbox"/>
<input type="text"/>	English <input checked="" type="checkbox"/>
<input type="text"/>	English <input checked="" type="checkbox"/>

Select format: HTML Text Wireless

Add personal message:

Not available for Wireless or non-English characters.

By selecting this check box and the Submit button, I agree to these [Terms and Conditions](#)

EXHIBIT E



FedEx Express U.S. Mail: PO Box 727
Customer Support Trace Memphis, TN 38194-4643
3875 Airways Boulevard
Module H, 4th Floor Telephone: 901-369-3600
Memphis, TN 38116

08/02/2005

Dear Customer:

The following is the proof of delivery you requested with the tracking number 832450794911

Delivery Information:

Status: Delivered **Delivery date:** Jul 12, 2005 09:15
Signed for by: Signature release on file
Service type: Priority Envelope

NO SIGNATURE IS AVAILABLE

FedEx Express Proof of delivery details appear below; however no signature is currently available for this FedEx Express shipment. Availability of signature images may take up to 5 days after delivery date.

Shipping Information:

Tracking number: 832450794911 **Ship date:** Jul 11, 2005
Recipient: US **Shipper:** SAN JUS

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Alexandria, VA 22313-1450
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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

COPY MAILED

MAY 04 2005

In re Application of
Brigitte Chau Phan et al.
Application No. 10/087,549
Filed: February 28, 2002
Attorney Docket No: BT12 00102703(USP3)
USP8

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition under 37 CFR 1.47(a) filed November 1, 2004, which is being treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.63 where they require that a supplemental declaration be executed by the named inventor.¹

The petition is GRANTED.

In view of the efforts recounted in the petition to obtain the signature of KaYuen Yeung, it is agreed that justice would be served by waiving the requirement for her signature on the supplemental declaration filed November 1, 2004.

The aforementioned supplemental declaration has been accepted, on petition, and placed in the file.

This matter is being referred to Technology Center 1634.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

EXHIBIT F

¹ Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.